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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
00/000000	00/00/00	WEINSTEIN	00000000

F3M1/1220

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ART UNIT	PAPER NUMBER
12/20/96 2	

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/532,965

Applicant(s)
Marvin A. Ornstein et al.

Examiner
Benjamin H. Layno

Group Art Unit
3304



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-64 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 9-19, 22-31, and 61-64 is/are allowed.
- ☒ Claim(s) 1-4, 20, 21, 40, 41, 48-54, and 57-59 is/are rejected.
- ☒ Claim(s) 5-8, 32-39, 42-47, 55, 56, and 60 is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 41 of U.S. Patent No. 5,570,885. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 41 of the patent recites all the limitations in claims 1-4 of the present application. However, the steps of “d) said player attempting to play a consecutive number of plays of the game in an attempt to win the number of consecutive play wins selected by the player in step (b)” and “(f) canceling the display when a player.....plays of the game selected by the player” in claim 41 of the patent are not recited in claims 1 and 2 of the present application. Furthermore, the step of “(c) presenting a display of the number of consecutive play wins selected by the player in step (b)” in claim 41 of the patent is not recited in claim 2 of the present application. Thus, claims 1 and 2 of the present application have broader claim language than claim 41 of the patent.

Claims 52-54 and 57-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 8-12 of U.S. Patent No. 5,570,885. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the patent recites all the limitations of claim 52 of the present application. However, the recitation “means responsive to said bet selector means and accumulating

means.....is equal to the number of consecutive play wins achieved by a player” in claim 2 of the patent, column 7, lines 56-65 is not recited in claim 52 of the present application. Thus, claim 52 of the present application has broader claim language than claim 2 of the patent.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-4 rejected under 35 U.S.C. 102(e) as being anticipated by Green.

The patent to Green discloses a Blackjack game having a consecutive win side bet area 40. To participate in the side bet, a player must place a PRESS chip on area 40. Green recites that “Once the player achieves a desired number of consecutive wins, the player may then stop his ‘PRESS’ bet and receive the designated payout amount time the amount of his ‘PRESS’ bet”. Also, Green recites that there is a limit to the number of consecutive wins the player desires, which is limited by the gaming establishment, see column 10, lines 35-41. Thus, the player selects

a number of consecutive wins from within a permitted range of numbers. Green recites "Each time a player wins his first player's position hand in the regular game, the dealer will take the first "PRESS" chip from that player's group and place the "PRESS" chip on top of the "PRESS" bet that has been made by the player. As long as the player continues to win his first player position consecutive hands in the regular game, his "PRESS" chip count will continue to increase" see column 10, lines 29-35. Thus, the player's stack of "PRESS" chips is a display of the payoff amount according to the number of consecutive wins selected by the player, and the amount of the wager initially made by the player. A stack having "PRESS" chips equal to the number of consecutive wins selected by the player, provides a winning indication of when the player wins the side bet. The payoff amount is the total number of "PRESS" chips in the stack, which is broadly based on pre-programmed payoff odds which correspond to different values of prospective consecutive wins. If the player loses a hand the house removes the stack of "PRESS" chips terminating the payoff.

4. Claims 20, 21, 40, 41 and 48-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 20 recites the limitation "said elevator means" in line 19. There is insufficient antecedent basis for this limitation in the claim.

6. Claims 40 and 41 recite the limitation "cards" in line 9. There is insufficient antecedent basis for this limitation in the claims. Furthermore, the preambles in claims 40 and 41 recite "the game of chance is craps". This is indefinite because there are no cards in the conventional game of craps.

7. Claims 48 and 49 recites the limitation "Push button", "a player having a hand" and "a

dealer's hand" in lines 2-5. There is insufficient antecedent basis for this limitation in the claims. Furthermore, claim 46, which claims 48 and 49 depend from, recites "the game of chance is roulette". This is indefinite because in the game roulette there is no dealer, there are no hands, and there are no pushes (ties).

8. Claims 50 and 51 recite the limitation "the dealer" in line 5. There is insufficient antecedent basis for this limitation in the claim. Furthermore, claim 47, which claims 50 and 51 depend from, recites "the game of chance is roulette". This is indefinite because in the game roulette there is no dealer.

9. Claims 9-19, 22-31 and 61-64 allowed.

10. Claims 20 and 21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action base claim and any intervening claims.

11. Claims 5-8, 32-39, 42-47, 55, 56 and ~~60~~ are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 40, 41 and 48-51 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter:

The Fresno Bee article discloses a Blackjack game where a player receive a bonus if the player gets three blackjacks in a row. The patent to Hobert discloses a craps game having a side bet. A player wins the side bet if a set of predetermined numbers appear during consecutive rolls of the dice. Hobert discloses a display which keeps track of the predetermined numbers that have been consecutively rolled. The patent to Smyth discloses a slot machine where a player wins a

prize if a designated symbol appears on the payline a number of times after a predetermined number of play cycles. Smyth's slot machine also discloses a display having a number of lights. A light turns on each time the designated symbol appears on the payline. The patent to Clarke discloses a slot machine where a player wins a prize if a predetermined number of consecutive lost games take place. The patent to Paulson discloses a betting apparatus for use in a blackjack game comprising a chip receptacle 12 for the placement of a chip representing a side bet. The chip receptacle has sensors 92, 96 for detecting the presence of a chip. Halaby discloses a gaming table having embedded chips. The table has holes or receptacles for receiving a simulated stack of chips. Each simulated stack of chips is mounted on an elevator underneath the hole, fig. 2. A drive means moves the elevator up and down thus varying the height of the stack of chips relative to the gaming table surface.

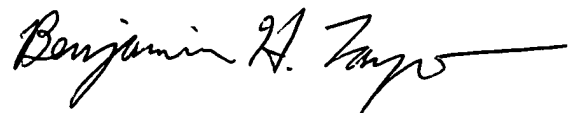
None of the cited references alone or in combination disclose the claimed step of covering the consecutive wins bet (chip or coin) within the receptacle. None of the cited references alone or in combination disclose the claimed combination of a chip receptacle, means for detecting a presence and denomination of a chip placed in the chip receptacle, display means and controller means as recited in claim 9. None of the cited references alone or in combination disclose the claimed combination of a chip receptacle, a transparent cover, a housing, means for movably mounting the chip receptacle, drive means, and elevator means as recited in claims 20 and 22.

None of the cited references alone or in combination disclose the claimed gaming machine having means for manually inputting a selected number of consecutive wins, means for displaying a selected number of consecutive wins as recited in claim 52.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Layno whose telephone number is (703) 308-1815.

bhl

December 12, 1996

A handwritten signature in cursive script, reading "Benjamin H. Layno", followed by a horizontal line.

BENJAMIN H. LAYNO
PRIMARY EXAMINER
GROUP 330